## REMARKS

Claims 1-22 are pending in the application. Claims 1, 4-15 and 17-22 have been amended. Reconsideration of this application is respectfully requested.

Claims 1, 4-15 and 17-22 have been amended to eliminate reference numbers. Claim 18 has been amended by changing a semi-colon to a period at the end thereof. As such, claims 1, 4-15 and 17-22 have been clarified by amendment for purposes of form. It is respectfully submitted that the amendments to claims 1, 4-15 and 17-22 are neither narrowing nor made for substantial reasons related to patentability as defined by the Court of Appeals for the Federal Circuit (CAFC) in Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 95-1066 (Fed. Cir. 2000). Therefore, the amendments to claims 1, 4-15 and 17-22 do not create prosecution history estoppel and, as such, the doctrine of equivalents is available for all of the elements of claims 1, 4-15 and 17-22.

The Office Action rejects claims 1, 3, 4, 7, 9, 11-18, 21 and 22 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 6,154,844 to Touboul et al., hereafter Touboul.

This rejection is erroneous because Touboul does not teach one or more features recited in these claims. First, Touboul lacks a virus-free certificate as recited in independent claims 1, 12-14, 21 and 22. These claims recite that the virus-free certificate comprises a file signature for certifying that the file is declared virus-free by a virus-free certificate authority.

Touboul generates a Downloadable Security Profile (DSP) that includes a list comprising all potentially hostile or suspicious computer operations that may

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be attempted by a Downloadable file (column 4, lines 4 to 6). Therefore, a DSP is a warning object that lists all potential hostile or suspicious operations or patterns. However, Touboul does not teach any testing of the Downloadable file and/or giving any indication that any anti-virus programs have been executed on the file). Touboul's DSP only identifies potential hostile or suspicious operations or patterns that may infect the Downloadable file, but does not give any information concerning any anti-virus programs that have been executed of that file. In other words, Touboul teaches to leave the execution of virus detecting programs to the end user who receives the Downloadable file.

Touboul's DSP object is different from the anti-virus certificate according to the present invention. The anti-virus certificate doesn't list potential viruses. If one anti-virus program detects a virus, no anti-virus certificate is generated. The anti-virus certificate doesn't list all potential viruses but only lists the anti-virus programs that have been used (with the program level and the date). The anti-virus certificate is a guaranty that the listed anti-virus programs have detected no virus. In contrast, Touboul generates a DSP that does not list or indicate that any anti-virus programs have been used to check the file. Thus, the content of the DSP and the content of the anti-virus certificate are completely different.

In fact the object of Touboul's DSP is for users to perform anti-virus programs based on the DSP list. The purpose of the present invention is to do nothing more than verifying/authenticating the anti-virus certificate and not to execute other verification programs such as local anti-virus programs. It is easy to see that the object of Touboul and the object of the present invention are completely opposed.

By the procedure of Touboul's Fig. 6, two certificates are attached to the Downloadable file. One of the certificates is a developer certificate 155 that enables inspector 125, network gateway 110 and computer client 130 to authenticate the developer of the Downloadable file (column 3, lines 51-65). The

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other certificate is an inspector certificate 170 that verifies the authenticity of the DSP attached to the Downloadable file (column 4, line 65 to column 5, line 1). It is clear that neither the developer certificate 155 nor the inspector certificate 170 certifies that the file is declared virus-free by a virus-free certificate authority as recited in independent claims 1, 12-14, 21 and 22. Therefore, Touboul lacks the virus-free certificate as recited in independent claims 1, 12-14, 21 and 22.

Since Touboul lacks a virus-free certificate as recited in independent claims 1, 12-14, 21 and 22, Touboul also lacks each every step recited in these claims.

Moreover, the Examiner's inference "that the action of sending a file to the inspector is an implied request for a virus inspection". There is no teaching or support in Touboul for this inference. Therefore, the inference is challenged.

For the reason set forth above, it is submitted that the rejection of claims 1, 3, 4, 7, 9, 11-18, 21 and 22 under 35 U.S.C. 102(b) as anticipated by Touboul is erroneous and should be withdrawn.

The Office Action rejects claims 2, 5, 6, 8, 19 and 20 under 35 U.S.C 103(a) as unpatentable over Touboul in view of U.S Patent No. 6,275,937 to Hailpern et al., hereafter Hailpern.

This rejection is erroneous. As noted above in the discussion of independent claims 1 and 14, from which claims 2, 5, 6, 8, 19 and 20 depend, Touboul lacks a virus-free certificate. Hailpern was not cited as teaching a virus-free certificate as recited in independent claims 1 and 14 and their respective dependent claims 2, 5, 6, 8, 19 and 20. Accordingly, the combination of Touboul and Hailpern does not teach a virus-free certificate and claims 2, 5, 6, 8, 19 and 20 are unobvious over such combination.

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The Examiner admits that Touboul does not teach that the virus-free certificate request comprise a list of one or a plurality of anti-virus free programs to execute on the file to determine whether the file is virus free or not as recited in claim 2. The Examiner contends that Hailpern does teach such a request and that it would be obvious to one of ordinary skill in the art to modify Touboul with the teachings of Hailpern.

The Examiner's contention is traversed. Hailpern's PRRR (PICS Processing Request Rule) is not a certificate according to the X.509 digital certificate standard. Rather it is a proprietary structure. Hailpern teaches a meta-information that is associated with the object provided by the client and modified and updated by the server. In contrast, the anti-virus certificate of the present invention is created by the server and there is no process for updating or modifying this anti-virus certificate as described at column 4, lines 51-65 of Hailpern.

Moreover, neither Touboul nor Hailpern discloses the combination of the different fields required to build an anti-virus certificate such as used in the present invention (standard X.509 certificate structure). Accordingly, the Examiner's contention is erroneous.

Moreover there is no motivation for one skilled in the art to combine Touboul and Hailpern. The Examiner cites that the motivation is the "need for a collaborative method for processing data objects (Column 3, lines 65 and 66 of Hailpern). This is the need to which Hailpern's method is directed. There is no relation between this need and/or Toulboul's method of notifying a user that certain types of virus may infect a file, leaving the execution of anti-virus programs to the user. Accordingly, there is no motivation to one of ordinary skill to combine Touboul and Hailpern.

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The Office Action suggestion to combine Touboul and Hailpern is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the reasons set forth above, it is submitted that the rejection of claims 2, 5, 6, 8, 19 and 20 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action rejects claim 10 under 35 U.S.C 103(a) as unpatentable over Touboul in view of U.S Patent Publication No. US 2003/0110376 A1 to Weiner et al., hereafter Weiner.

This rejection is erroneous. As noted above in the discussion of independent claim 1, from which claim 10 depends, Touboul lacks a virus-free certificate. Weiner was not cited as teaching a virus-free certificate as recited in independent claim 1 and dependent claim 10. Accordingly, the combination of Touboul and Weiner does not teach a virus-free certificate and claim 10 is unobvious over such combination.
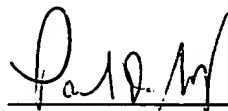
For the reason set forth above, it is submitted that the rejection of claim 10 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action cites a number of patents that were not applied in the rejections of the claims. These patents have been reviewed, but are believed to be inapplicable to the claims.

It is respectfully requested for the reasons set forth above that the rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) be withdrawn, that claims 1-22 be allowed and that this application be passed to issue.

Respectfully Submitted,

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Paul D. Greeley
Reg. No. 31,019
Attorney for Applicants
Ohlandt, Greeley, Ruggiero & Perle, L.L.P.
One Landmark Square, 10th Floor
Stamford, CT 06901-2682
(203) 327-4500